

THIS DISPOSITION
IS NOT CITABLE AS
PRECEDENT OF
THE TTAB

Mailed: May 14, 2004
Paper No. 13
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shark Abrasion Systems Pty. Ltd.

Serial No. 76417366

Mark B. Harrison of Venable for Shark Abrasion Systems Pty.
Ltd.

William T. Verhosek, Trademark Examining Attorney, Law
Office 114 (Margaret Le, Managing Attorney).

Before Walters, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Shark Abrasion Systems Pty. Ltd. has filed an
application to register the mark SHARK on the Principal
Register for "earthmoving equipment, namely, mechanical
excavators and loaders; ground engaging tools for use with

mechanical diggers and loaders, namely, shrouds, lips, adaptors and teeth," in International Class 7.¹

The Trademark Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark SHARK CHAIN previously registered for "chain comprised of digging bits for trenching machines"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.³ The cited registration includes a disclaimer of CHAIN apart from the mark as a whole.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours & Co.*,

¹ Serial No. 76417366, filed May 31, 2002, based on, under Section 1(b) of the Trademark Act, an allegation of a bona fide intention to use the mark in commerce and, under Section 44(e) of the Trademark Act, Australian Registration No. 878474, dated June 8, 2001.

² Registration No. 2083884 issued July 29, 1997, to Consolidated Carbide, in International Class 7. [Sections 8 and 15 affidavits accepted and acknowledged, respectively.]

³ The Examining Attorney included two additional registrations, Registration Nos. 0740900 and 0740901, in his final refusal to register under Section 2(d). However, these two registrations expired and, in his denial of applicant's request for reconsideration on the Section 2(d) issue, the Examining Attorney withdrew these two registrations as a basis for the refusal.

476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

The Examining Attorney contends that the dominant portion of the registered mark is SHARK because it is the first term in the mark and it is followed by the generic name of the goods; that applicant's mark is identical to the dominant portion of the registered mark; and that the commercial impressions of the marks are the same. Regarding the goods, he argues that the record establishes that the respective goods may emanate from the same source; that "'trenching machines' and 'earthmoving equipment' such as excavators, diggers and loaders are generally machines manufactured, sold and used in the same channels of trade"; that "'trenching machines' encompass ... 'excavators, diggers and loaders'"; that "some trenching machines may also refer

to earthmoving equipment, excavators, diggers and loaders and vice versa"; that "chains are used on excavators, loaders and diggers"; and that "shrouds, lips, adaptors and teeth are common component parts of trenching machines." In support of his position, the Examining Attorney submitted excerpts of articles and patents retrieved from the LEXIS/NEXIS database and copies of third-party registrations for marks, alleging use in commerce, on goods encompassing both applicant's goods and the goods in the cited registration.

Applicant contends that the marks, considered in their entirety, create different commercial impressions; and that the goods are unrelated. Applicant argues that a trenching machine is "a relatively expensive piece of equipment [that] is 'a giant ditch digger' which operates by rotating steel tracks around a large boom that resembles the blade of a chainsaw"; that both applicant's and registrant's goods are "highly specialized and highly priced"; and that the evidence of record supports the conclusion that the channels of trade are different. Applicant states that only four of the third-party registrations submitted by the Examining Attorney mention the term "chains"; that only two of these four registrations mention goods similar to applicant's goods and these two registrations do not cover registrant's specific type of chains; and that this evidence

does not establish that applicant's and registrant's goods are related. Similarly, applicant argues that the patent excerpts are inapposite and, further, do not "represent how real life consumers would encounter either the applicant's goods or the registrant's goods."⁴ Applicant states that the mere fact that the goods recited in the application and registration may pertain to digging, in the broadest sense, does not support a conclusion that the goods are sufficiently related to support a finding of likelihood of confusion. Applicant submitted excerpts from Internet web sites that show and discuss the types of products involved in this case. The following are several examples:

"Loadmaster Lip Systems - The loadmaster system is an innovative new bucket lip designed to meet your needs for improved lip performance and longevity. Loadmaster lips are designed for use on hydraulic face shovels, front-end loaders, and excavators found in the construction market. ... Loadmaster lips feature SUPER V® tooth systems for penetration and long life, and the Toplok® tooth systems for penetration and long life, and the Toplok® shrouds for longer lip wear life and fast, easy changes."
[www.powermotivecorp.com/parts/groundEngagingTool, August 14, 2003.]

"Toplok Shroud Benefits - Shrouds wrap around leading edge of lip, extending time before lip rework is needed. Shroud is designed for penetration while providing maximum protection, keeping your machine working longer."
[www.texconeqp.com, August 4, 2003.]

⁴ We are not considering the patent evidence for purposes of determining consumer perception of the terminology in regard to a descriptiveness refusal. Rather, the patent evidence is pertinent to determining the nature of the goods involved herein in regard to a likelihood of confusion refusal. Thus, such evidence is relevant and has been considered.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We agree with the Examining Attorney that SHARK is the dominant portion of the registered mark. Not only is it the first term in the mark, but also the second term, CHAIN, is a generic term for the identified goods. Consumers would likely see the CHAIN portion of the mark SHARK CHAIN as

merely identifying the particular SHARK goods involved so that the term SHARK would dominate the commercial impression of the mark SHARK CHAIN. Thus, we conclude that the marks SHARK and SHARK CHAIN are substantially similar in overall commercial impression.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

The following examples are excerpts from the LEXIS/NEXIS database submitted by the Examining Attorney:

"'We've got everything for design firms and contractors,' said Parsons. 'Its not a home show that the general public would be interested in.' Not unless they feel the need to drive home in a \$400,000 trenching machine or a front-end loader." [Charleston Gazette, March 24, 1998.]

"Trencor designs, manufactures and markets chain and wheel trenching equipment, canal excavators, rock saws, roadminers and log handling equipment. ... Trencor's chain trenching machines use a heavy-duty chain wrapped around a long movable boom. These machines, with weights up to 400,000 pounds, are capable of cutting a trench up to eight feet

wide and 30 feet deep." [*Tennessee Manufacturer*, September 1996.]

"`A tree's root system is like a plate: flat, thin and wide-spreading,' says Thompson. `It's well within the range of any trenching machine. Chain-driven ditch-diggers and backhoes are the tree's worst enemy.'" [*Charlotte Observer*, August 23, 1995.]

"... business volume in the earthmoving segment is expected to show increases of 13.1 percent for the U.S., 10.2 percent for Canada and 11.5 percent for other export markets. The earthmoving segment includes excavators, loaders, graders and trenching machines." [*Concrete Products*, December 1998.]

"The best machine for a particular project depends on several jobsite-specific considerations. Trenching machines and hydraulic excavators are totally different in design and function, yet both are widely used to dig trench[es] for underground-utility installations. Each offers specific advantages." [*Construction Equipment*, August 1998.]

The following examples are excerpted from the LEXIS/NEXIS patent database submitted by the Examining Attorney:

"Another object of the present invention is to provide a novel arrangement of alternate digging elements and digger cleaning elements on a trenching machine chain to increase the effective capacity of the machine and buckets." [Patent No. 3006087, *Bucket Line for Trenching Machine*.]

"... a point spaced therealong with the openings whereby it may be securely anchored in desired position upon a trenching machine, excavator, or other earth digging apparatus or devices. While my invention may be employed with many different types of earth ..." [Patent No. 2250904, *Tooth for Earth Digging Devices*.]

The Examining Attorney submitted 24 third-party registrations to establish that marks are registered for

both applicant's and registrant's goods. The majority of these registrations are of limited value because a number of the identifications of goods specify various excavators including, for example, backhoes, loaders, graders and bulldozers, but do not also specify trenchers; and only two of the registrations include "chains" (one specifically limited to chains for trenching machines). Additionally, those registrations that pertain to mining and/or drilling parts are clearly inapposite. However, several of the registrations include both earthmoving equipment and machine parts for such equipment; and several of the registrations include bits for earthmoving tools/equipment.

The evidence in this case establishes that a trenching machine is a piece of earthmoving equipment; that digging bits are used on a wide range of earthmoving equipment, including trenching machines; and that at least some trenching machines have chains to which the digging bits are attached. It is also apparent from the evidence that earthmoving equipment is very expensive and used on a broad commercial scale for a wide range of purposes.

The evidence does not establish that "mechanical excavators and loaders" (identified in the application) *include* "trenching machines" or that chains are used on other types of earthmoving equipment. But such a showing is not required. Goods or services need not be identical or

even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

In this case, it is clear that various types of earthmoving equipment and parts for such equipment may come from the same source. While the specific goods involved herein are not the same, they are sufficiently related that, if identified by confusingly similar marks, confusion as to source is likely. Given the expense of a single piece of earthmoving equipment, it is clear that considerable care will be involved in such a purchase and that purchasers are likely to be very knowledgeable. However, there is no evidence that the parts for such equipment are expensive or that the same amount of care or same purchasers are involved in purchasing replacement parts for this equipment. Further, knowledgeable business purchasers are not immune from confusion when the marks are as similar as these marks

and there is evidence that goods of the type with which these marks are used or intended to be used do sometimes emanate from the same source. *See In re General Electric Company*, 180 USPQ 542 (TTAB 1973).

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, SHARK, and registrant's mark, SHARK CHAIN, their contemporaneous use on the goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The refusal under Section 2(d) of the Act is affirmed.